

Attorney Docket No. P71162US0
Application No. 10/573,049

Remarks/Arguments:

Claims 57-68, presented hereby, are pending.

Claims 1-56 are canceled, without prejudice or disclaimer.

Present (method of use) claim 57 combines subject matter of claim 35 and claim 56—as an independent claim. Present dependent claims 58-68 correspond to claims 31, 36-39, 41, 43, and 52-55, respectively, rewritten to be dependent—directly or indirectly—on present claim 57 and, otherwise, to more clearly define the instant invention.

The objection to claims 32 and 33 is rendered moot by cancellation of claims 32 and 33, hereby. Withdrawal of the objection appears to be in order.

Claim 40 was rejected under 35 USC 112, ¶2, for allegedly being indefinite. Reconsideration is requested in view of the rejected claim being cancelled, hereby.

It should be pointed out that "how many nucleotide sequences may be present" concerns claim scope/breadth and, as such, fails to justify the §112, ¶2, rejection. A concern about the scope of the language at issue has no bearing on whether the term is indefinite under §112, ¶2, since claim "breadth is not to be equated with indefiniteness." *In re Miller*, 169 USPQ 597, 600 (CCPA 1970). Although an "undoubtedly large number" of embodiments might fall within the scope of a generic expression "the expression is not for that reason indefinite," *In re Skoll*, 187 USPQ 481, 482 (CCPA 1975), and whether a particular embodiment is covered by the expression "is rendered no less certain by the large number." 187 USPQ at 483.

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For the foregoing reasons, the rejection under §112, ¶2, is overcome. Withdrawal of the rejection appears to be in order.

Claims 30-54 and 49-51 were rejected under 35 USC 102(e) for allegedly being anticipated by US 6,838,433. Reconsideration is requested.

US 6,838,433 neither teaches nor suggests the "antibody" limitation (i.e., "antibody containing an antigen-binding site for IL-6 and/or the IL-6 receptor") on all the present claims. US6,838,433 discloses, at best, IL-6 antagonist peptides.

Accordingly, the "absence" from US 6,838,433 of the aforesaid *antibody* limitation "negates anticipation" of any of the present claims by the reference. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986). Withdrawal of the rejection appears to be in order.

Claims 30-50 were rejected under 35 USC 102(e) for allegedly being anticipated by the WO publication corresponding to US 7,320,792 (Ito). Reconsideration is requested.

Ito exclusively discloses a method of treating psoriasis. On the other hand, the present *method-of-use* claims are limited to use for "reducing IL-6 concentration and/or unoccupied IL-6 receptor concentration," and *treatments* effected thereby, none of which *uses* is taught or suggested by Ito. Even assuming, *arguendo*, that Ito discloses an antibody containing an antigen-binding site for IL-6 and/or the IL-6 receptor, as alleged in the statement of rejection, "New uses of old products or processes are indeed patentable subject matter." *Perricone v. Medicis Pharmaceutical Corp.*, 77 USPQ2d 1321, 1328 (Fed. Cir. 2005).

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Accordingly, the "absence" from Ito of the aforesaid *use* limitations "negates anticipation" of any of the present claims by the reference. *Kolster Speedsteel A B*, 230 USPQ at 84. *Perricone*, 77 USPQ2d at 1328. Withdrawal of the rejection appears to be in order.

Claim 51 was rejected under 35 USC 103(a) for allegedly being obvious over Ito in view of US 7,344,716 (Di Mauro). Reconsideration is requested.

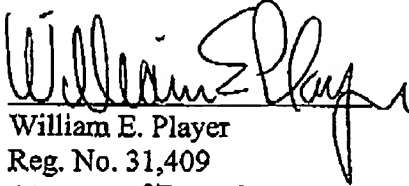
As explained above, Ito fails to teach or suggest the *use* limitations on the present *method-of-use* claims. Similarly, Di Mauro fails to teach or suggest the use for "reducing IL-6 concentration and/or unoccupied IL-6 receptor concentration," and *treatments* effected thereby, to which the present *method-of-use* claims are limited.

Accordingly, since "the cited references do not support each limitation of [the *method of treatment*] claim[s]" the rejection is "inadequate on its face" against any of the present *method of use* claims. *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). Withdrawal of the rejection appears to be in order.

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Favorable action is requested.

Respectfully submitted,


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